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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,222	11/07/2001	Richard J. Gambino	A31982-I	3216
21003	7590	02/05/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			RESAN, STEVAN A	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,222

Applicant(s)

GAMBINO ET AL.

Examiner

Stevan A. Resan

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 17, 19-23, 25-27, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 19-23, 25-27, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1773

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Nov 21 2003 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 16,19-22 and 25-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lyman US 3985588.

Lyman discloses an article of manufacture having magnetocrystalline anisotropic magnetic energy comprising a substrate and a single magnetic coating fixidly attached to the substrate and having an easy magnetic axis . The coating comprises magnetic particles in a matrix sprayed onto the substrate in the presence of an applied magnetic field. (See figure, Col 2 lines 38-42; Col 3 lines 21-25,31-32, 53-54, 56-61; Col 5 line 65- Col 6 line10). While Lyman does not recite the spraying as a part of a "thermal process" he discloses that the process may be conducted at elevated emperatures.(Nevertheless

Art Unit: 1773

the process limitations have not been given weight since they have not been shown to produce a patentable article.)

Lyman teaches that the matrix material any suitable resinous material which will harden or polymerize under ambient or elevated temperature (Col 5 lines 15-18). The examiner broadly interprets this to include resins which may be thermoplastic in nature. The use of SmCo_5 (which inherently has a coercivity of over 150 Oe) and the magnetization conditions disclosed to form the article are deemed to produce an article of > 2,200 Oe as in claims 21,27, the amount and degree of dispersion (i.e. density) of magnetic particles being a results effective variable determining the overall coercivity and energy product.

5. Claims 16,17,19-23 and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlin et al US 6468678 and Toliver et al 6217252 for the reasons of record.

6. Applicant's arguments filed 11-21-2003 have been fully considered but they are not persuasive.

Applicant has amended claim 16 to limit the article to one with a "single" flexible magnetic coating and argues that Dahlin et al teaches away from the invention since the embodiments have several layers. However Dahlin does not teach several magnetic layers.

Claim 30 which requires the magnetic layer to be fixedly attached without an adhesive layer does not distinguish over the combination of references since Toliver teaches a single layer of binder (matrix) material on a substrate with magnetic particles

Art Unit: 1773


"in the layer" (see Fig 4) which would meet the claim 30 limitation of having magnetic particles **"into or onto matrix material"**.

The layer of Tolliver is flame sprayed (which is a thermal spray process but as previously pointed out process limitations can be given no weight in article claims unless it can be shown that they produce a patentably distinct article). However such a flame spray process would necessarily result in low levels of volatile organic compounds in the finished product as in claim 31.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (571) 272-1513. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (571) 272-1516.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


STEVAN A. RESAN
PRIMARY EXAMINER